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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,628	10/17/2003	Vivian Agura	60655.1800	2587
66170 7590 02/04/2010 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER				
SHIN, MIN				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
02/04/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/688,628

**Applicant(s)**

AGURA ET AL.

**Examiner**

MIN SHIN

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to the amendment filed on 10/13/2009 . Claims 1-4, 7-16 are currently pending and have been considered below.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 and 7-16 rejected under 35 U.S.C. 102(e) as being anticipated by Fredregill (US 2005/0144074).

#### Claims 1

Fredregill disclose a method that allows the user to redeem loyalty points, comprising:

providing an interface for identifying a transaction for an item;

collecting the transaction in the user's electronic shopping cart (paragraph 0056; "When

**the order form is complete, the user interface provides an option, via a visual control, to move the designated items to a storage area of memory known as the "shopping cart"**

**212. The "shopping cart" function displays the designated items currently placed in the "shopping cart", along with pricing information for each designated item)**

repeating the steps of identifying and collecting transactions until the user is ready to check out;

calculating an amount of loyalty points necessary to complete the collected transactions; calculating an amount of first loyalty points from a first loyalty program that are available in an account for the user in the computer system (paragraph 0005 and 0058; The system immediately **adds the associated loyalty program award point total to an initial consumer award point total retrieved from the consumer award account record and stores the revised point total in the centralized data storage in real time.** “A portion of the user interface displays an additional electronic form that provides the customer with an option to redeem points in exchange for a discount on the order. **Also, information representative of a minimum point redemption amount may be specified, along with information representative of the fixed increments of points available for redemption);**

transferring second loyalty points, from a second loyalty program, to the computer system from another account in a second computer system connected to the computer system by a network (paragraph 0005, 0040 and 0041; “The functions available for access from the service desk work station 16 include: balance inquiry, **transfer points, point balance adjustments, point refund**, certificate issuance, merchandise order, add/change alternate identification, cancel/reissue customer card, enter enrollment data, and modify enrollment data. **The transfer points function allows the retailer to assist customers in consolidating points between two customer accounts).**

verifying that a total amount of the first loyalty points that are initially available in the account for the user in the computer system and the second loyalty points transferred from

the other account in the second computer system meets the amount of points necessary to complete the collected transactions (paragraph 0005 and paragraph 0044; **“The merchandise order function provides the retailer with the ability to assist the customer in redeeming points for catalog items. When the customer seeks to purchase catalog items, the customer account is verified through the on-line point server 42 to insure that the customer has a sufficient point total in order to redeem a specified catalog item. If the customer account has sufficient points, the point total is debited in real-time by the number of points necessary for purchase of the selected catalog item); and**

proceeding to an electronic checkout to complete the collected transactions

(see also Abstract; **Upon user engagement, the Internet web site transmits the consumer identification data and the coupon number to the loyalty program host system. The loyalty program host system queries the information received and locates a consumer award account record and a coupon record. The consumer award account record includes an associated consumer loyalty program point total, and the coupon record, associated with the unique coupon identification number, has the associated loyalty program award point total)**

Claim 2:

Fredregill discloses the method of claim 1 as above and further discloses wherein the collected transactions comprise independent and dependent transactions (paragraph 0058).

Claim 3:

Fredregill discloses the method of claim 1 as above and further discloses wherein the collected transactions comprise transactions for non-tangible items and transactions for tangible items (paragraph 0056).

Claim 4:

Fredregill disclose a method that allows the user to redeem loyalty points, comprising:  
providing an interface for identifying a transaction for an item;  
providing an electronic shopping cart for collecting the transaction in the for the specified item (paragraph 0056; **"When the order form is complete, the user interface provides an option, via a visual control, to move the designated items to a storage area of memory known as the "shopping cart" 212.** The "shopping cart" function displays the designated items currently placed in the "shopping cart", along with pricing information for each designated item)

calculating an amount of loyalty points necessary to complete the collected transactions;  
calculating an amount of first loyalty points from a first loyalty program that are available in an account for the user in the computer system system (paragraph 0005 and 0058; The system immediately **adds the associated loyalty program award point total to an initial consumer award point total retrieved from the consumer award account record and stores the revised point total in the centralized data storage in real time.** "A portion of the user interface displays an additional electronic form that provides the customer with an option to redeem points in exchange for a discount on the order. **Also, information**

**representative of a minimum point redemption amount may be specified, along with information representative of the fixed increments of points available for redemption);**

transferring second loyalty points, from a second loyalty program, to the computer system from another account in a second computer system connected to the computer system by a network (paragraph 0040 and 0041; “The functions available for access from the service desk work station 16 include: balance inquiry, **transfer points, point balance adjustments, point refund**, certificate issuance, merchandise order, add/change alternate identification, cancel/reissue customer card, enter enrollment data, and modify enrollment data.” **The transfer points function allows the retailer to assist customers in consolidating points between two customer accounts).**

verifying that a total amount of the first loyalty points that are initially available in the account for the user in the computer system and the second loyalty points transferred from the other account in the second computer system meets the amount of points necessary to complete the collected transactions (paragraph 0044; “**The merchandise order function provides the retailer with the ability to assist the customer in redeeming points for catalog items. When the customer seeks to purchase catalog items, the customer account is verified through the on-line point server 42 to insure that the customer has a sufficient point total in order to redeem a specified catalog item.** If the customer account has sufficient points, the point total is debited in real-time by the number of points necessary for purchase of the selected catalog item); and  
processing each of the collected transactions.

(see also Abstract; **Upon user engagement, the Internet web site transmits the consumer identification data and the coupon number to the loyalty program host system. The loyalty program host system queries the information received and locates a consumer award account record and a coupon record. The consumer award account record includes an associated consumer loyalty program point total, and the coupon record, associated with the unique coupon identification number, has the associated loyalty program award point total).**

Claim 7:

Fredregill discloses the method of claim 4 as above and further discloses wherein the collected transactions comprise independent and dependent transactions (paragraph 0058).

Claim 8:

Fredregill discloses the method of claim 4 as above and further discloses wherein the collected transactions comprise transactions for non-tangible items and transactions for tangible items (paragraph 0056).

Claims 11 and 15:

Fredregill discloses the method of claim 1 and 4 as above and further discloses wherein the collected transactions comprise a transaction for gifting a product containing a currency credit to another individual (paragraph 0030; " Customers may redeem the points earned when purchasing a redeemable item in a number of ways, **including gift certificates**

and/or catalog items at the retailer service desk, Customers may redeem the points earned when purchasing a redeemable item in a number of ways, including gift certificates and/or catalog items at the retailer service desk”).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-10, 12-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredregill (US 2005/0144074).

Fredregill discloses the method of claims 1 and 4 as above but fails to disclose wherein the collected transaction comprises a transaction for generating charitable donations, making contribution to IRA account and converting points to pay for bills.

**Official Notice:**

However, it is old and well known within the marketing arts to allow loyalty members to use reward/award points earned in many other forms such as charitable donations or redeem as cash reward which the members can utilize as they see fit (e.g. invest, donate or purchase).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention, to incorporate the above disclosure (Official Notice) into the system of Fredregill so as to generate charitable donations, making investments or converting to cash in

order to give the loyalty members diverse choices on the redemption and to further improve the marketing effect of the loyalty program.

***Response to Arguments***

6. Claims 1 and 4: The applicant has amended the claim to now recite "transferring second loyalty points, from the second loyalty program, in a second computer connected to the computer system by a network." and "verifying that a total amount of the first loyalty points that are initially available in the account for the user in the computer system and the second loyalty points transferred from the other account in the second computer system meets the amount of points necessary to complete the collected transactions." The applicant argues that Fredregill fails to disclose that *"transferred points are from a second loyalty program and second computer system."* and *"idea of centralized data is no suggestive of a second account and second computer system.. nothing in Fredregill suggests Any sort of integration.."* Examiner disagrees. Though the claims attempts to distinguish a first and second loyalty program and a separate computer system, it fails to narrow the scope to overcome the rejection. The first and second loyalty program does not have any functional difference as it is recited in the claim. Basically, two separate loyalty accounts in Fredregill can be considered two loyalty programs depending on how an user intends to use the two separate loyalty account. Further, having a *separate second* computer also does not narrow the scope of the claim to render it patentable distinct especially in a *method* claim. Having one computer system or multiple separate computer systems still can perform the exact same recited steps of the claims 1 and 4. Most computer systems are interconnected network of

separate computer systems. Whether they are "central" or "separate" computer systems has very little bearing in the claims. Examiner does understand the applicant's reasoning for having first and second loyalty program and a separate computer system. However, the claims as they are recited, fails to functionally distinguish first and second loyalty or first and second computer systems.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not convincing and thus, the current Office Action has been made Final.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner notes that the following references included in the Applicant's information disclosure statements are also very pertinent to the invention and include many, if not all, of the claimed invention

- Postrel (US 6,594,640) A system and method for operating a reward points accumulation and redemption program wherein a user earns reward points from a plurality of independent reward points issuing entities, with each tracking the user's earned reward points in a user reward point account stored on a rewards server (such as a frequent flyer account or a credit card loyalty account). On selective request by the user, a trading server accumulates some or all of the user's earned reward points from the reward servers and credits the accumulated points

into a single reward exchange account associated with the user. The user may then select an item for purchase with the accumulated reward points. The item is provided to the user in exchange for a subset or all of the reward points.

- Ikeda (US 5,937,391) A service system in an online shopping mall established through a network realizes an improvement of a service to a customer by not having to carry a magnetic card and shortening a time from issuing points to redeeming points. To attain the objects of the system, a points issuing unit issues points corresponding to the purchase amount of a customer. A points storage device stores the number of points accumulated by the customer. A points redeeming unit reduces a purchase amount of the customer as points to be redeemed. A points issue ratio and a points redeeming ratio can be set for each shop forming part of the online shopping mall.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MIN SHIN whose telephone number is (571)270-3463. The examiner can normally be reached on Mon-Fri 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weinhardt Robert can be reached on 571-272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS  
1/28/2010

/Jean Janvier/  
Primary Examiner, Art Unit 3688